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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,221	05/22/2007	Hans B. Bauerfeind	5790-0103PUS1	6953

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EXAMINER
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NICHOLSON, KERI JESSICA

ART UNIT	PAPER NUMBER
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3772

NOTIFICATION DATE	DELIVERY MODE
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06/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,221	<b>Applicant(s)</b> BAUERFEIND ET AL.	
	<b>Examiner</b> KERI J. NICHOLSON	<b>Art Unit</b> 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is the second Office action based on non-provisional application 10/590,221 filed August 22, 2006 for the amendments to the claims filed February 19, 2009. Claims 1-11 have been amended; claims 1-11 are currently pending.

#### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1 recites the limitation “superimposed layers”; however, there is insufficient antecedent basis for this limitation in the current specification.

#### ***Claim Objections***

2. Claim 1 is objected to because it appears that the limitation “an inner side of the bandage” in line 9 should be “the inner side of the bandage” since an inner side of the bandage was previously recited in the claim and would provide antecedent basis for the second recitation. Otherwise it is unclear if the second recitation of “an inner side of the bandage” is intended to be different from the first recitation.

3. Claim 2 is objected to because there is insufficient antecedent basis for the limitation “the stimulation device” since the recitation of “a stimulation device” in the preamble of claim 1 does not positively claim the limitation. It is suggested that Applicant should either amend claim 1 to positively recite a stimulation device in the body of the claim or amend claim 2 such that it recites “a stimulation device” rather than “the stimulation device”.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the claimed recitation of “superimposed layers” such that the claim language is now broader than what was originally recited and may encompass more than what is disclosed by the applicant. Therefore, the scope of the claim is unclear and the term “superimposed layers” is being considered new matter.
6. Claims 2-11 are rejected under 35 U.S.C. 112, first paragraph, for depending from a rejected base claim.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The newly added limitation “wherein an area of the electrode includes superimposed layers consisting of the electrodes on an inner side of the bandage, the elastic region of the bandage, and the pocket on an outer side of the bandage” is unclear because the electrode itself cannot include both the bandage and the pocket. For examination purposes, claim 1 has

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been interpreted such that it is an area of the elastic bandage as a whole, not just the electrodes, which includes the electrodes, an elastic region of the bandage, and the pockets.

Further, claim 1 recites the limitation "the pocket on an outer side of the bandage" in lines 9-10; however, there is insufficient antecedent basis for this limitation in the claim since the pocket is only recited to be location on an outer side of the electrodes in line 5. The outer side of the electrodes and the outer side of the bandage are not necessarily the same unless specifically indicated. For examination purposes, the above limitation has been interpreted as "the pocket on the outer side of the electrodes".

9. Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, for depending from a rejected base claim.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minogue et al. (US Patent Pub. 2002/0128686) in view of Bray (US Patent 6,520,893). Minogue discloses an elastic bandage (belt, 25) comprising electrodes (26/27) connected to a detachable electric stimulation device (signal generator, 28) by means of lead wires (cables, 59/60) such that the electrodes are located on an inner side of an elastic region of the bandage and an outer side of the electrodes is covered by a pocket (formed from stitching together outer layers, 49 with edging braid, 51) containing a resilient cushion (foam layer, 50), wherein an area of the elastic bandage includes layers consisting of the electrodes on the inner side of the elastic bandage,

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an elastic region of the bandage, and the pocket on an outer side of the electrodes (Figs. 4-6 & 10; page 6, ¶ 130; page 7, ¶ 137). However, Minogue fails to explicitly teach that the pocket of resilient foam is less elastic than the bandage or that the resilient cushion consists of an inflatable tube.

Bray discloses a belt (20) comprising an inflatable air chamber (32) positioned within a pocket formed between two sides (28/30) and a backing (36) having much less elasticity than the inner side (28) and positioned adjacent to the inflatable air chamber so that when the inflatable air chamber is inflated, it expands away from the backing and toward the inside (Figs. 3-4; column 3, lines 2-30). At the time the invention was made, it would have been obvious to one having ordinary skill in the art to modify the bandage taught by Minogue such that the pocket contains an inflatable air chamber and a back panel that is less elastic than the bandage as taught by Bray for the purpose of applying adjustable pressure on the user to provide therapy that meets the individual user's needs.

### ***Response to Arguments***

12. Applicant's arguments filed February 19, 2009 have been fully considered but they are not persuasive.

13. In response to Applicant's argument that Bray does not disclose electrodes, the examiner notes that Bray was not relied upon to teach electrodes as they were taught by Minogue.

14. In response to Applicant's argument that there is no suggestion to combine the references or that the inflatable air chamber taught by Bray could not be used as a cushion in connection with electrodes as in the bandage taught by Minogue, the examiner disagrees and recognizes that obviousness can only be established by combining or modifying the teachings

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of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the bandage taught by Minogue forms a pocket between the outer layers and the edge braiding in which a cushion is located. Similarly, Bray discloses a bandage having a pocket formed between the two sides in which an inflatable air chamber is located. Therefore, it would have been obvious to modify the bandage taught by Minogue to include an inflatable air chamber in the pocket in the manner taught by Bray for exerting pressure on the user. The electrodes on the bandage taught by Minogue and as modified by Bray would not be affected by the inclusion of the inflatable cushion.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERI J. NICHOLSON whose telephone number is 571-270-3821. The examiner can normally be reached on Monday - Thursday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJN  
/Keri J. Nicholson/  
Examiner, Art Unit 3772  
6/3/2009

/Patricia Bianco/  
Supervisory Patent Examiner, Art Unit 3772